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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/732,348	12/07/2000	Yen Choo	674538-2001	1675

7590 07/16/2002

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[REDACTED] EXAMINER

COLLINS, CYNTHIA E

ART UNIT	PAPER NUMBER
1638	16

DATE MAILED: 07/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Offic Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/732,348	CHOO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Stuart Baum	1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on \_\_\_\_\_.  
 2a) This action is **FINAL**.                  2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-23 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) \_\_\_\_ is/are rejected.  
 7) Claim(s) \_\_\_\_ is/are objected to.  
 8) Claim(s) 1-23 are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 11) The proposed drawing correction filed on \_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.  
 12) The oath or declaration is objected to by the Examiner.

#### **Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.  
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.  
 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### **Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Supplemental Restriction***

Applicant's election of Group III, claims 7-8, in the response filed February 14, 2002, is acknowledged. Upon further consideration, and in light the addition of claims 10-23, the previous restriction requirement, mailed January 15, 2002, has been withdrawn in favor of the restriction requirement set forth below. The Office regrets any inconvenience to the Applicant.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 5, drawn to a method of regulating transcription comprising introducing into a plant cell an engineered zinc finger polypeptide fused to a transcriptional activator domain, classified in class 530, subclass 350, for example.
- II. Claim 6, drawn to a method of regulating transcription comprising introducing into a plant cell an engineered zinc finger polypeptide fused to a transcriptional repressor domain, classified in class 530, subclass 350, for example.
- III. Claims 15 and 22, drawn to a plant host cell and transgenic plant comprising a polynucleotide encoding an engineered zinc finger polypeptide fused to a transcriptional activator domain, classified in class 435, subclass 419, for example.
- IV. Claims 16 and 23, drawn to a plant host cell and transgenic plant comprising a polynucleotide encoding an engineered zinc finger polypeptide fused to a transcriptional repressor domain, classified in class 800, subclass 298, for example.

The inventions are distinct, each from the other because of the following reasons:

Claims 1-4 and 9 link(s) inventions I-II. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claims 1-4 and 9. Claims 7-8, 10-14 and 17-21 link(s) inventions III-IV. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s). Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Inventions I-IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation or different effects.

Inventions I and II have different effects. The method of Invention I upregulates transcription as a consequence of a zinc finger polypeptide being fused to a transcriptional activator domain, whereas the method of Invention II downregulates transcription as a consequence of a zinc finger polypeptide being fused to a transcriptional repressor domain.

Inventions III and IV have a different mode of operation from Inventions I and II. The methods of Inventions I and II comprise introducing an engineered zinc finger polypeptide directly into a plant cell, whereas the plant host cell and transgenic plant of Inventions III and IV comprise a polynucleotide encoding an engineered zinc finger polypeptide. Accordingly, since the methods of Inventions I and II do not require a polynucleotide encoding an engineered zinc finger polypeptide, the plant host cell and transgenic plant of Inventions III and IV are made by a method other than the methods of Inventions I and II. Additionally, the plant host cell and transgenic plant of Inventions III and IV comprise structurally and functionally distinct polynucleotides, namely a polynucleotide encoding an engineered zinc finger polypeptide fused to a transcriptional activator domain in the case of Invention III, and a polynucleotide encoding an engineered zinc finger polypeptide fused to a transcriptional repressor domain in the case of Invention IV.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, their recognized divergent subject matter, and the requirement for different areas of search, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Remarks***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (703) 605-1210. The examiner can normally be reached on Monday-Friday 8:45 AM -5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

CC  
July 13, 2002



PHUONG T. BUI  
PRIMARY EXAMINER